

REMARKS/ARGUMENTS

In the Amendment dated October 31, 2003, claim 22 was inadvertently canceled instead of claim 23. The undersigned apologizes for this mistake and respectfully requests that claim 23 be cancelled instead. Original claim 22 has been presented as a new claim 42. It is respectfully requested that the Examiner enter this amendment as shown in the listing of claims for the Examiner's convenience.

In the Office Communication, the Examiner has asserted that the Amendment dated October 31, 2003 is non-responsive for not fully addressing: the objections to Figs. 2 and 4 (item 2 of the Office Action), objections to the specification based on improper use of trademark (item 4 of the Office Action) and clearly pointing out the novelty of claims pursuant to 37 CFR § 1.111. These objections are fully traversed below.

Objections to the Drawings

In the Office Action dated July 31, 2003, the Examiner has asserted that Fig. 2 and Fig. 4 should be designated as prior art because only that which is old is illustrated (Office Action, item 2). It is respectfully submitted that neither Fig. 2 nor Fig. 4 should be submitted as prior art because these figures do not illustrate only that which is old. Among other things, it should be noted that the present application claims priority from U.S. Provisional Application Number 60/141,071, filed June 25, 1999, Attorney Docket No. SUN1P249P/P4205PSP, entitled "JAVA SERVER PAGES SPECIFICATION"; and claims priority from U.S. Provisional Application Number 60/149,508, filed August 17, 1999, Attorney Docket No. SUN1P260P, entitled "JAVASERVER PAGES SPECIFICATION". As such, the embodiments illustrated in Fig. 2 and Fig. 4 do not constitute prior art.

Thus, contrary to the Examiner' assertion, Fig. 2 and Fig. 4 should not be labeled as "prior art." Accordingly, it is respectfully submitted that this objection is improper and should be withdrawn by the Examiner.

Objections to the Specification

In the Office Action dated July 31, 2003, the Examiner has also asserted that trademark language should be capitalized and accompanied by generic terminology (Office Action, item 4). Initially, it is respectfully submitted that the undersigned earnestly believes that there is no legal requirement that would suggest that every instance of trademark language must be accompanied by generic terminology. It is respectfully requested that the Examiner provide the Applicant with any evidence to the contrary. Furthermore, it is respectfully submitted the some programming languages or specific software products are well known to those skilled in the art by a trademark name (e.g., JavaServer™, Coldfusion™). As such, it is NOT necessary to accompany these trademark names with generic terminology. Furthermore, in some cases it may be inappropriate to use generic terminology if a programming language or product is primarily known to those skilled in the art by its trademark name (e.g., Java programming language).

Nevertheless, pursuant to Examiner's suggestions, the Applicant has accompanied the trademark name Java with generic terminology. The Applicant has also capitalized trademark names in an attempt to respect the proprietary nature of the marks and to make every effort to prevent their use in a manner that might adversely affect their validity as trademarks, pursuant to guidelines set forth in MPEP 608.01(v). In addition, the undersigned earnestly believes that the trademark names have been used appropriately pursuant to guidelines set forth by the assignee itself (Sun Microsystems Inc.). The Applicant has painstakingly made these efforts solely in order to expedite prosecution of the present application and respectfully requests that the Examiner withdraw all rejections.

Claim Rejections

It is respectfully submitted that the undersigned has clearly pointing out the novelty of claims pursuant to 37 CFR 1.111. As noted in the amendment filed October 31, 2003, the cited art, among other things, does not teach or suggest providing a tag-handler object for a custom action tag in the context of the invention. The tag handler provides a run-time representation of the custom action tag and includes a do-start method for processing of a start-tag, a do-body method for processing of the body, and a do-end method for processing of the end-tag of the custom action tag. It is earnestly

believed that a tag-handler object for a custom action tag has not been addressed by the Examiner. In fact, this is a feature that is believed NOT to have been recited in the original claims. Thus, the Examiner could not have possibly addressed this feature. In any case, the Applicant has clearly pointed out the novelty of the amended claims pursuant to 37 CFR § 1.111 for this reason alone.

Furthermore, it was noted in the amendment filed October 31, 2003, that the cited art does not teach or suggest invoking the do-body method and processing, by the do-body method, the body of the custom action tag to translate the body from a first scripting language to platform independent code that can be executed to perform actions intended by the custom action tag. It was also noted that the cited art cannot teach or suggest determining, by the do-body method, whether further processing is required to translate the body from a first scripting language to platform independent code that can be executed to perform the actions intended by the custom action. In addition, it was noted that the cited art teach or suggest invoking the do-end method of the tag-handler object when the do-body method determines that no further processing is required. Again, it is respectfully submitted that the Applicant has clearly pointing out the novelty of the amended claims pursuant to 37 CFR 1.111 for these additional reasons.

Still Further, it was submitted that the Examiner has not addressed several of the features. These features include addressed include: (a) generating and storing code for any attribute values in a tag instance, (b) instantiating the tag, (d) creating a BodyEvaluation object if necessary, and (g) synchronizing any indicated scripting variables. These features are recited in claim 42.

In addition to the amendments and arguments submitted in the amendment dated October 31, 2003, it is respectfully submitted that the Office Action has not established a *prima facie* case of obviousness. To establish a *prima facie* case, the Patent and Trademark Office must satisfy three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or to combine references. See In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); In re Skinner, 2 U.S.P.Q.2d 1788, 1790 (Bd. Pat. App. & Int. 1986).

Often times, particularly with the aid of hindsight, the art appears combinable or modifiable in a manner that will yield the claimed invention. That itself will not make the resultant modification obvious, however. The art must still suggest the desirability of the modification. The mere fact that references *can* be combined or modified does not render the resulting combination obvious. See In re Gordon, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) ('The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."); In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990) (Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.") see also MPEP § 2143.01.)

In the Office Action dated July 31, 2003, the Examiner has stated that one skilled in the art would be motivated to modify the *Staugaard* to implement the claimed operations within an HTML web-page environment in which a page containing a tag is translated while preserving the tag structure as taught by *JSRef* (Office Action, item 16). Although one of ordinary skilled in the art may be motivated to achieve portability, it is respectfully submitted that one of ordinary skilled in the art would not have been motivated to use or modify *Staugaard* to implement the claimed operations. *Staugaard* pertains to Structured and Object-Oriented Techniques Using C++ programming language. On the other hand, *JSRef* pertains to a reference manual for using JavaScript language. As noted by the Examiner, C++ programming language is not platform independent. Hence, *Staugaard* cannot be properly combined with *JSRef* because of this serious deficiency of *Staugaard*. Furthermore, it should be noted that *Staugaard* does not pertain to a scripting programming language. Hence, it is respectfully submitted that *Staugaard* cannot be properly combined with a scripting language (e.g., JavaScript language) to achieve the claimed operations.

Accordingly, it is respectfully submitted that the art relied upon in the Office Action contains no suggestion that would have motivated one of skill in the art to modify a reference or to combine references. The titles of these references indicate this fact. Nevertheless, the Office Action notes that various combinations or modifications of the prior art would have been "obvious to one ordinarily skilled in the art." However, a statement that combinations or modifications of the prior art would have been within the capabilities of one of ordinary skill in the art is not sufficient to establish a *prima facie*

case of obviousness. (See, e.g., Ex parte Levengood, 28 USPQ 2d 1300 (Bd.Pat.App.&Inter. 1993); (see also MPEP § 2143.01.) Thus, the assertion that one skilled in the art would be motivated to gain advantage of cross-platform client-server portability is not sufficient to establish a *prima facie* case of obviousness.

Based on the foregoing, it is submitted that claims 26-42 are patentably distinct over the cited art of record. Additional limitations recited in the independent claims or the dependent claims are not further discussed as the limitations discussed above are sufficient to distinguish the claimed invention from the cited art. Accordingly, Applicant believes that all pending claims are allowable and respectfully requests a Notice of Allowance for this application from the Examiner.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 500388 (Order No. SUN1P253). Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,
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APPENDIX A